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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,470	09/07/2000	Kouji Ueda	Q60746	1700

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EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 07/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-17

Office Action Summary

Application No.

09/657,470

Applicant(s)

UEDA ET AL.

Examiner

Sikyln Ip

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-10-03;05-12-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1 and 3-19 are rejected under 35 U.S.C. § 103 as being unpatentable over prior art admission in view of JP 61133357 and further teaching of JP 60174842.

4. The prior art admission in page 1, lines 6-16 of the instant specification disclose(s) the features including the claimed Cu base machined retainer of rolling bearing containing Al, Mn, Ni, and/or Fe elements. The difference between the reference(s) and the claims are as follows: the prior art admission does not disclose intermetallic compound and its area ratio, retainer material hardness. However, JP

61133357 in the abstract disclose(s) Cu base bearing alloy used in the same field of endeavor has up to 17% area ratio of dispersed intermetallic compound. JP

60174842 in the abstract discloses the bearing material hardness is more than Hv 400. Since the Pb contents in cited references and instant claims are low enough to read on impurity level which appears has no effect to the hardness. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to use bearing Cu base alloy as taught by JP 61133357 and JP 60174842 in order to improve high resistance to abrasion and seizure (See abstracts). In re Venner, 120 USPQ 193 (CCPA 1958), In re LaVerne, et al., 108 USPQ 335, and In re Aller, et al., 105 USPQ 233.

5. With respect to the claimed intermetallic compounds in claim 10 that the claimed intermetallic compounds are one of the material properties of the alloy. Since instant Cu base material is overlapped by the cited reference and there are no special conditions for instant casting and cooling steps; consequently, the intermetallic compounds as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re Best, 195 USPQ, 430 and

MPEP §2112.01.

6. It is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one ordinary skilled in the art would have expected them to have the same properties, In re Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (Fed. Cir. 1985), In re Woodruff, 16 USPQ 2d 1934, In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970), and In re Payne 606 F.2d 303, 203 USPQ 245 (CCPA 1979). To overcome the prima facie case, an applicant must show that there are substantial, actual differences between the properties of the claimed compound and the prior art compound. Hoch, 428 F.2d at 1343-44, 166 USPQ at 409.

7. With respect to the casting method as recited in claims 11 and 18, that the invention defined in a product-by-process claim is a product, not a process. In re Bridgeford, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966). The guidance that has been provided by court on this matter is:

[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

In re Thorpe, 777 F.2d 695, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

8. Applicant's arguments filed March 10, 2003 have been fully considered but

they are not persuasive.

9. Applicants in page 4 of the instant remarks argue that the hardness difference between claimed product and product of cited references have shown the claimed product is functionally/structurally different from product of cited references. But the instant Figure 6 does not set forth the upper limit of the instant hardness.

Furthermore, instant claims 3 and 4 have open upper hardness values.

10. Applicants argue that the cited references fail to teach reducing Pb. But, conventionally, brass cast-Category 1 as is recited in JIS 5101 (submitted by applicants) has less than 0.5 wt.% Pb. Furthermore, the Pb content as disclosed by JP61133357 overlaps the claimed Pb content.

11. Applicants argue that the instant Exhibits A and B have shown the claimed Pb content is critical. But, it is clear from the Exhibit B that no Pb has the smoothest surface, which Pb content is outside the claimed Pb content. And increased Pb content is expected to roughening the bearing surface.

12. Applicants in page 6 of the instant remarks argue that the claimed alloy has high machinability. But applicants have not compared their alloys with alloys of cited references and have not been substantiated their position by factual evidence with declaration.

13. Applicants argue that the instant Figure 7 show the claimed Pb content is

critical. But, Figure 7 also shows 0 wt.% Pb has a smoother surface.

14. Applicants argue that instant Tables 4 and 6 show hardness, volume of abrasion, and impact resistance are affected by Pb content. But, the alloys in said Tables do not have the same composition other Pb. Comparison must be done under identical condition except for the novel features of the invention. In re Brown, 173 USPQ 685 and In re Chapman, 148 USPQ 711. The showing of unexpected results must be occurred over the entire claimed range. In re Clemens, 622 F.2d 1029, 206 USPQ 289, 296 (CCPA 1980). The scope of the showing must be commensurate with the scope of the claims. In re Tiffin, 448 F.2d 791, 792 (Fed. Cir. 1971), In re Coleman, 205 USPQ 1172, and In re Greenfield, 197 USPQ 227.

15. Applicants argue that the material of cited references are not direct to a machine retainer of rolling bearing. But, there is no structure of the claimed retainer and cited references are also direct to bearing material.

Conclusion

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been meet by the rejections as set forth above.

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Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.


Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



**SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742**

S. Ip
July 28, 2003